

**REMARKS**

**INTRODUCTION:**

The Applicants request reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1-32 are pending and under consideration. Claims 1, 4, 10, 20, 21, 22, 24, 25, and 27-32 are the independent claims.

Claim 29 has been amended.

Claims 1-6, 10-12, 20-21, 28, and 30-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yonemitsu et al. (U.S. Patent No. 5,734,787).

Claims 7-9, 13-19, 22-27, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yonemitsu et al. (U.S. Patent No. 5,734,787) in view of the admitted prior art disclosed in Figure 1 of the present application.

On pages 2-3 of the Office Action, the Examiner provisionally rejects claims 1-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending application no. 09/534,493. The rejection is traversed, and reconsideration is respectfully requested.

The specification has been amended to clarify typographical errors as would have been understood by one skilled in the art.

No new matter is being presented, approval and entry of the forgoing amendments is respectfully requested.

**REJECTION UNDER 35 U.S.C. §102(e):**

On pages 2-3 of the Office Action, the Examiner rejects claims 1-6, 10-12, 20-21, 28, and 30-32 under 35 U.S.C. § 102(b) as being anticipated by Yonemitsu et al. (U.S. Patent No. 5,734,787). The Applicants respectfully traverse the rejection and request reconsideration.

The Examiner references Figure 13, as well as column 5, lines 43-54, and column 18, lines 10-16, of Yonemitsu et al. as disclosing an optical disc recording/reproducing apparatus showing all the limitations recited in claims 1, 20, and 31 of the present application. The Applicants respectfully submit that original claims 1 and 31 of the present invention are not drawn to all optical discs, but to "CD-type disc[s]" as recited therein.

The citation, however, is specifically drawn to non-CD-type discs. The Applicants respectfully submit that it is commonly known in the art that CD-type discs have a specified physical format. Specifically, CD-type discs have a track pitch of 1.6 microns  $\pm 0.1$  micron. The disclosure of the citation is specifically limited to an alternate optical disc design that utilizes a track pitch of 0.646 microns - 1.05 microns to increase the recording density of the optical disc. This alternate physical format is described in column 2, line 63 through column 3, line 2 of the citation, which states:

In accordance with this invention, an optical disk, a method and apparatus for recording that disk and a method and apparatus for reading data from that disk are provided. The disk has a diameter of less than 140 mm, a thickness of  $1.2\text{mm} \pm 0.1\text{mm}$ , and a plurality of record tracks exhibiting a track pitch in the range between  $0.646\text{ }\mu\text{m}$  and  $1.05\text{ }\mu\text{m}$  with data recorded in those tracks as embossed pits.

The restriction as to track pitch is repeated throughout Yonemitsu et al., including: the abstract, col. 5, lines 63-66, and the claims.

Accordingly, the Applicants submit that the citation does not disclose the CD-type disk as recited in claims 1 and 31, and therefore, the rejection is deemed moot. The Applicants respectfully request reconsideration and allowance of these claims.

The Applicants respectfully submit that claim 20, which recites a method of recording on a disc physically divided into a lead-in area, a lead-out area and a user area, comprising: formatting the lead-in area, the lead-out area and the user area according to a compact disc read only memory format; and recording information in a digital versatile disc application format in the user area, is also patentably distinct from the citation. In the second paragraph of item 2 of the Office Action, the Examiner rejects claim 20, stating that the Yonemitsu et al. discloses a lead-in area, a lead-out area, a user area with a compact disc format, and the information having a DVD application format. The Applicants respectfully submit that even if the Examiner's statements are accepted *arguendo*, the rejection does not address the recitation in claim 20 of lead-in and lead-out areas having a CD-ROM format while a user area has a DVD format. While Yonemitsu et al. may disclose an optical disc that can be formatted for CD or DVD formats, it does not disclose or suggest a disc where both formats are present at the same time. Particularly, column 5, lines 45-48, of the citation state that the recorded data, "may be file data or application data to be used by a computer, or it may comprise video data." This portion of the citation, which was cited by the Examiner, makes clear that one format or another is used, and therefore does not disclose or suggest the multiple concurrent formats of the present invention as recited in claim 20.

The Applicants respectfully submit that claim 32, which recites in part an application audio/video (A/V) encoder to encode a received A/V signal into a second format type to provide an A/V stream, and a first formatter to format the A/V stream according to a predetermined file system for an application of the second format type, is patentably distinct over Yonemitsu et al. Specifically, the citation does not disclose or suggest a second formatter having the recited features noted above. While the citation may record recording application information on a disc for the purpose of facilitating identification and reproduction of DVD signal, the citation does not disclose encoding a received A/V signal into a second format to provide an A/V stream, and then formatting the A/V stream according to a predetermined file system.

The Applicants respectfully submit that independent claims 4, 10, 21, and 28 are all patentable over the Yonemitsu et al. for reasons similar to those detailed above with respect to claims 1 and 31, and dependent claims 2, 3, 5, 6, 11, and 12 are patentable over Yonemitsu et al. for at least the same reasons as their respective base claims, as well as for any additional features they recite.

While claim 30 was listed as rejected in the first line of item 2, no explanation of the rejection was given. The Applicants assume that the rejection of claim 30 is for similar reasons to the rejection of claim 29. Accordingly, the Applicants submit that claim 30 is patentable for reasons similar to those detailed above with respect to claim 29. If the Applicants assumption is incorrect, the Applicants respectfully request that the Examiner clarify the basis for the rejection of claim 30.

REJECTION UNDER 35 U.S.C. §103(a):

On pages 4-6, item 5, of the Office Action, the Examiner rejects claims 7-9, 13-19, 22-27, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Yonemitsu et al. (U.S. Patent No. 5,734,787) in view of the admitted prior art disclosed in Figure 1 of the present application.

Initially, the Applicants note that claim 29 has been herein amended to recite a CD-type disc.

The Applicants initially submit that independent claims 22, 24, 25, and 27, along with amended claim 29 all recite CD-type discs. Therefore, the Applicants respectfully submit that these claims are allowable for similar reasons to those detailed above with regard to claims 1 and 31.

The Applicants further submit that dependent claims 23 and 26 are patentable over Yonemitsu et al. for at least the same reasons as their respective base claims, as well as for any additional features they recite.

OBVIOUSNESS TYPE DOUBLE PATENTING:

On pages 6-7 of the Office Action, the Examiner provisionally rejects claims 1-32 under the judicially created doctrine of obviousness type double patenting in view of claims 1-29 of copending application No. 09/534,493. The rejection is traversed, and reconsideration is respectfully requested.

In view of the enclosed Terminal Disclaimer, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 1-32.

CONCLUSION:

In accordance with the foregoing, the specification and claim 29 have been amended. Claims 1-32 are pending and under consideration.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: \_\_\_\_\_

5/10/04

By: \_\_\_\_\_



Michael D. Stein  
Registration No. 37,240

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501